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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,887	02/09/2001	George A. Pecoraro	1657A1	9023

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PPG INDUSTRIES INC
INTELLECTUAL PROPERTY DEPT
ONE PPG PLACE
PITTSBURGH, PA 15272

EXAMINER

BOLDEN, ELIZABETH A

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/780,887

Applicant(s)

PECORARO ET AL.

Examiner

Elizabeth A. Bolden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-16, 18, 19 and 21-25 is/are pending in the application.

4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-16, 18, 19 and 21-25 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8 & 13. 6) ☐ Other:

DETAILED ACTION

Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn.

Claim Objections

Claim 19 is objected to for not clearly recited the alkali oxide limitations. Claim 19 recites "Na₂O is from 12 to 15 weight percent and K₂O from 0 to 5 weight percent" and further recites a combined Na₂O and K₂O content of from 10 to 15 weight percent. The lower limit of Na₂O is 12 wt% which is greater than the combined Na₂O and K₂O limitation in claim 19.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 is indefinite for failing to further limit the claim from which it depends, claim 19. Claim 19 recites a limitation "CaO + MgO from 12.74 to less than 13.4 weight percent", wherein depending claim 18 recites a limitation "CaO + MgO from 12.5 to 13 weight percent". This range is broader than the claim from which it depends, rendering claim 18 indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14-16, 18, 19, and 21-25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Morimoto et al., U.S. Patent 5,362,689.

Morimoto et al. disclose an infrared and ultraviolet ray absorbing flat glass having overlapping ranges of components with instant claims 14-16, 18, 19, 22, and 25. See abstract of Morimoto et al. The compositional ranges disclosed by the reference are sufficiently specific to anticipate the compositional limitations in claims 14-16, 18, 19, 22, and 25. See MPEP 2131.03.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Morimoto et al. would inherently have the same viscosity properties as recited in claims 19, 21, 23, and 24. See MPEP 2112.

Claim 22 define the product by how the product was made. Thus, claim 22 is a product-by-process claim. For purposes of examination, product-by-process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present case, the recited steps imply a structure of a flat or float glass comprising MgO and CaO. The reference suggests such a product. See column 1, lines 9-15 of Morimoto et al.

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Claims 14-16, 18, 19, 22, 23, and 25 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Nakashima et al., U.S. Patent 6,313,052.

Nakashima et al. disclose a glass substrate having overlapping ranges of components with instant claims 14-16, 18, 19, 22, and 25. See abstract of Nakashima et al. The compositional ranges disclosed by the reference are sufficiently specific to anticipate the compositional limitations in claims 14-16, 18, 19, 22, and 25. See MPEP 2131.03. Nakashima et al. disclose glass composition having overlapping ranges of log 4 viscosity with instant claims 19 and 23. See column 3, lines 58-61 and column 4, lines 3-4.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Nakashima et al. would inherently have the same log 2 viscosity properties as recited in claims 19 and 23. See MPEP 2112.

Claim 22 define the product by how the product was made. Thus, claim 22 is a product-by-process claim. For purposes of examination, product-by-process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present case, the recited steps imply a structure of a flat or float glass comprising MgO and CaO. The reference suggests such a product. See column 3, lines 7-10 of Nakashima et al.

Claims 14-16, 18, 19, and 21-25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Seto et al., U.S. Patent 5,998,316.

Seto et al. disclose an infrared and ultraviolet ray absorbing flat glass having overlapping ranges of components with instant claims 14-16, 18, 19, 22, and 25. See abstract of Seto et al. and column 3, lines 35-42. The compositional ranges disclosed by the reference are sufficiently

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specific to anticipate the compositional limitations in claims 14-16, 18, 19, 22, and 25. See MPEP 2131.03.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Seto et al. would inherently have the same viscosity properties as recited in claims 19, 21, 23, and 24. See MPEP 2112.

Claim 22 define the product by how the product was made. Thus, claim 22 is a product-by-process claim. For purposes of examination, product-by-process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present case, the recited steps imply a structure of a flat or float glass comprising MgO and CaO. The reference suggests such a product. See column 5, lines 58-62 of Seto et al.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 14-16, 18, 19, and 21-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-31 of copending Application No. 09/974,124. Although the conflicting claims are not identical, they

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are not patentably distinct from each other because the glass of U.S. Patent application 09/974,124 has overlapping compositional ranges with the glass of the present claims. See claims 17-31 of 09/974,124.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed 18 March 2003 have been fully considered but they are not persuasive.

Applicants assert that Morimoto et al. and Nakashima et al. do not have the claimed CaO+ MgO content and the claimed CaO/MgO ratio. This argument is not deemed persuasive. As Noted in the rejections above, the references disclose the claimed CaO + MgO content and the claimed CaO/MgO ratios. Applicants assert that the examiner has not provided extrinsic evidence to prove that the claimed properties are inherent to the glasses of the references. The examiner's understanding of inherency is derived from MPEP 2112. This section states:

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In the present case, the technical reasoning flows from the fact that “products of identical compositions cannot have mutually exclusive properties.” See MPEP 2112.01. (Citing in re Spada, 15 PQ2d 1655, 1658 (CCPA 1990)). In other words, the compositions of the references fall squarely within the presently claimed compositional ranges and therefore these compositions must have the same properties as those claimed.

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The examiner further notes that MPEP 2112 states that:

“[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency’ under 35 U.S.C. 102, on prima facie obviousness’ under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted].” The burden of proof is similar to that required with respect to product-by-process claims. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

Applicants further assert that the “certain thing” (in this case the properties) does not flow naturally from the references. The examiner disagrees. The ‘certain thing’ flows from the reference because, again, identical compositions must have the same properties. MPEP 2112

The Examiner acknowledges Applicant’s statement showing that the instant application and co-pending application 09/974,124 were commonly owned at the time of the invention in the paper file 17 May 2003.

Conclusion

The additional references cited on the 892 have been cited as art of interest since they are cumulative to or less than the art relied upon in the rejections above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Bolden whose telephone number is 703-305-0124. The examiner can normally be reached on 8:30am to 6:00 pm with alternating Fridays off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Mark L. Bell can be reached on 703-308-3823. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

EAB
June 25, 2003



DAVID SAMPLE
PRIMARY EXAMINER